UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,607	09/22/2003	Satoshi Suda	9868/1680-US0	9764

76808 7590 03/30/2011

Leason Ellis LLP
81 Main Street
Suite 503
White Plains, NY 10601

EXAMINER	
MOSSER, ROBERT E	

ART UNIT	PAPER NUMBER
3714	

MAIL DATE	DELIVERY MODE
03/30/2011	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/667,607	SUDA ET AL.	
	Examiner	Art Unit	
	ROBERT MOSSER	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 February 2011*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6-11,14-16,18-20 and 22-29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,6-11,14-16,18-20 and 22-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *9/22/2003* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 10th, 2011 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims **1-4, 6-11, 14-16, 18-20, and 22-29** are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the differentiation of winning symbol combinations, does not reasonably provide enablement for the "uniquely" visual differentiation of wins including a wild symbol from other wins. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

In particular the claim description of "uniquely visual differentiates" as reflected in independent claims **1, 8, 18,** and **24**, denotes a presentation of wild symbol

combinations that is not reflected in the presentation of other wins, yet the while the specification describe a presentation of the wild symbol combinations it does not exclude the presentation of other wins from being similarly presented. There is no language present in the specification as originally presented that would otherwise indicate that the applicant's presentation of wild symbol winning arrangements would be exclusive and hence unique from the presentation of other winning combinations. Further the applicant cites paragraph 0054, 0055 and 0060 for support of the claim amendments yet no support for the limiting of the differentiation feature to only the wild symbol inclusive combinations or specific reference to the term uniquely could be readily identified. Appropriate correction is required.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the uniquely identifying wins that include the wild symbol from other wins as claimed must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet,

and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **1-4, 6, 8-11, 18-20, 22,** and **24-29** are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Bennett (US 6,419,579) in view of Cannon et al (US 5,766,074) in further view of Inoue (US 6,942,572), in yet further view of Yoseloff (US 6,311,976) in yet further view of Kaminkow (US 6,837,790).

Claims **1-2, 4, 6, 8, 10-11, 18, 20, 22,** and **24-29**: Bennett teaches a gaming machine comprising:

a display module with multiple display areas contained therein for displaying a changing display including the changing of multiple symbols (reel spin feature) at the start of a game (*Bennett* Figure 1, Col 1:60-67);

a plurality of symbols including at least one wild symbol (*Bennett* Fig 3, Col 2:1-21);

the display of multiplication factor with the presentation of the wild symbol in combination with winning arrangements of symbols (*Bennett* Figure 3 Col 1:51-2:11, 2:42-44)

multiple win lines comprising a subset of the plurality of symbols (*Bennett* Col 3:25-35);

a static display of the plurality symbols on multiple areas of the display module (*Bennett* Figure 1, Col 1:60-67); and

an evaluation module for identifying multiple winning arrangements of symbols and wild symbols on the display such that the wild symbol establishes multiple predefined wins (*Bennett* Figure 1, Col 4:29-5:25)

Though arguably implicit to the nature of gaming devices the prior art of Bennett does not explicitly describe the presentation of game symbols in a static array both prior to the initiation of a game and after the conclusion of a game. In a related teaching however, Cannon teaches the presentation of game symbols in a static array both prior to the initiation of a game and after the conclusion of a game as a series repeating games (*Cannon* Figure 3). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the repeated presentation of static symbol arrays before and after game plays as taught by Cannon into the invention of Bennett in order to provide the player with the ability to review game results for a previous game at a user selectable time period concluded in the player initiation of a subsequent game.

While the combination of Bennett & Cannon is arguably silent regarding visually differentiating the winning combinations generated on the display, the related invention of Inoue teaches the unique visual differentiation of winning combinations through the use of alternating different colors of Illumination in a gaming machine to highlight multiple different winning outcomes including winning outcomes with common symbols (*Inoue* Figure 4 Abstract Col 2:25-35, 6:25-45, 7:64-8:11). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the unique winning outcome identification features of Inoue into the combination of Bennett & Cannon in order to clearly present the winning game symbol results to the player thereby preventing confusion as taught by Inoue (*Inoue* Col 2:5-36)

In the combination of Bennett, Cannon, & Inoue, Inoue teaches the alternating identification different winning arrangements including the "repeated illumination" of

symbols understood to implicitly require a time interval. The combination of Bennett, Cannon, & Inoue is silent regarding the utilization of a time interval to change a wild symbol present in a winning combination to other specific symbols that complete the winning arrangement however the related invention of Yoseloff teaches the morphing (a process understood to inherently include transformation over a time interval) of a wild symbol into a specific game symbol as to complete a winning combination (*Yoseloff* Col 8:44-46, 10:21-29, 11:22-37). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the wild symbol morphing features of Yoseloff into the combination of Bennett, Cannon, & Inoue in order to clearly present to the player the specific game symbol that the wild symbol is substituting.

Though the combination of Bennett, Cannon, Inoue, &Yoseloff teaches the gaming device as set forth above, the combination is silent regarding the incorporation of a vibration feature such that a display mechanism vibrates when a multiple win feature including a common wild symbol occurs. In a related invention however, Kaminkow teaches the inclusion of a vibration feature for vibrating displayed game elements in an electronic wager game wherein the feature is further taught by Kaminkow as being readily adaptable to a plurality game trigger events (*Kaminkow* Col 2:16-37, 5:25-32). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the features of the vibration feature as taught by Kaminkow into the invention of Bennett, Inoue, and Yoseloff in order to provide the player with additional entertainment and excitement as taught by Kaminkow (*Kaminkow* Col 2:54-60). Claim language extending the vibration of game elements to a plurality of

game symbols is understood as encompassed by the teachings of Kaminkow and in the alternative thereto representing an obvious duplication of parts (per MPEP 2144.04.VI.B) of Kaminkow in the combination of Bennett, Cannon, Inoue, Yoseloff & Kaminkow that would have been obvious to one of ordinary skill in the art at the time of invention to draw attention to the morphing transformation taking place and the additional payouts formed though the morphing of the game symbols provided by Yoseloff and Inoue in the combination of Bennett, Inoue, Yoseloff & Kaminkow.

Claim **3, 9,** and **19**: In addition to the presentation of Yoseloff as presented above Bennett teaches the sequential displaying of multiple winning arrangements with a changing wild symbol, in which multiple wins are established (*Bennett* Col 4:29-5:25).

Claims **7, 14-16,** and **23** are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Bennett (US 6,419,579) in view of Cannon et al (US 5,766,074) in further view of Inoue (US 6,942,572), in yet further view of Yoseloff (US 6,311,976), Kaminkow (US 6,837,790) as applied to claims **1-4, 6, 8-11, 18-20, 22,** and **24-29** above and further in view of Hamano (US 5,205,555).

Though teaching teaches the gaming device as set forth above and including teaching the presentation of a multiplier symbol with the presentation of a wild symbol on the reel display (*Bennett* Col 1:61-2:11; Figure 3), the combination of Bennett, Cannon, Inoue, Yoseloff, & Kaminkow is silent regarding the incorporation of multiplier that are predetermined based on the symbol combination. In a related invention

however, Hamano teaches the display and inclusion of predefined multipliers resultant on the arrangement of game symbols in a multi-reel slot machine (*Hamano* Figures 15-16, Col 1:38-2:39) to make a slot machine game more entertaining and a more exciting experience. It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the predefined multipliers resultant on the arrangement of the game symbols of Hamano into the combination with the symbols of Bennett, Cannon, Inoue, Yoseloff, & Kaminkow in order to make a slot machine game more entertaining and a more exciting experience as taught by Hamano.

Response to Arguments

Applicant's arguments dated February 10th, 2011 with respect to claims **1-4, 6-11, 14-16, 18-20,** and **22-29** have been considered but are not persuasive.

On the first two pages (Pages 10 & 11) of the applicant's remarks the applicant challenges the rejection of claims under 35 USC 112 and Objection to Drawings based on the removal of the claimed subject matter directed to the morphing of game symbols. Upon review of the claims however upon review of the claims, a new issue under 35 USC 112 and Objection to Drawings has been introduced by the inclusion of the language of "uniquely visually differentiating". According the afore mentioned rejection under 35 USC 112 and Objection to Drawings is maintained with respect to the pending claims. While the Examiner understands that the applicant is attempting to separate the presentation of the wild symbol outcomes from normal win outcomes, the specification

as presented while defining properties of the wild symbol inclusive wins does not expressly prohibit those properties from the presentation of normal non-wild symbol payout combinations. Such would be simply required in order for the respective presentations to be uniquely visually differentiated from one another as now claimed and under a conventional and plain interpretation of the term unique. The applicant's remarks only point to paragraphs 0054, 0055 and 0060 of the printed publication and do not otherwise assist in resolving this effective gap between the now claimed invention and the subject matter as presented in the application as originally filed.

On page 13 of the applicants remarks the applicant acknowledges the rejections characterization of Inoue for it's respective teaching of providing a distinct color based identification of each winning combination presented on a reel display but holds that as presented in the combination of references forming the rejection that they do not hold this as a valid position for teaching uniquely visually differentiating winning arrangements including a wild symbol from other winning arrangements. The reliance of the pending rejection on Inoue and with relation to this feature is based on Inoue's teaching of visually differentiation each and every winning combination from all other winning combinations while the particulars of the visual differentiation based on a time interval are provided for through the incorporation of Yoseloff.

Continuing on page 13 the applicant alleges that the prior art of Yoseloff a) fails to teach that the symbols morph on a continual basis to be alternatively displayed and further that Yoseloff allegedly b) fails to teach uniquely distinguishing between wins that incorporate a wild symbol and those which do not.

a) As presented in the applied prior art, Yoseloff teaches the visual transformation of game symbols (morphing) while the prior art of Inoue teaches the visual modification of game symbols in an alternate manner. Accordingly the applicant's arguments are non-persuasive as the two described game features are provided for by the combination of prior art as presented herein above.

b) The prior art of Inoue teaches the differentiation of multiple winning patterns from one another while Yoseloff teaches the further identification of winning symbol combinations including a wild symbol through the morphing of the wild symbol contained in the winning pattern. Accordingly the applicant's arguments are non-persuasive as the two described game features are provided for by the combination of prior art as presented herein above.

On page 14 the applicant argues that the prior art of Kaminkow teaches the vibration of entire images and portions of images but allegedly does not teach the specific vibration of one or more symbol or portions thereof.

The claimed feature does not prohibit the vibration of the entire screen and all images contained thereon. Further, Kaminkow additionally teaches the vibration of image portions as acknowledged by the applicant's remarks. The inclusion of game symbols and modification thereof has been provided by at least the prior art of Bennett in the rejection of record. Accordingly the applicant's arguments are non-persuasive as the two described game features are provided for by the combination of prior art as presented herein above.

Continuing on page 14 the applicant argues that the prior art of Humano allegedly teaches the consideration of multiplier values associated with a singular winning arrangement juxtaposed to the consideration of multiplier values associated with multiple winning arrangements. Additionally, the applicant presents that the invention of Humano does not teach the inclusion of a wild symbol.

First, the use of wild symbols including wild symbols forming multiple winning arrangements is provided for in the rejection of record with specific regards to the prior art of Bennett. Humano is provided in the combination of references forming the rejection of record to teach the inclusion and presentation of multiplier values based on game symbol outcomes. Accordingly while Humano does not address the specific type of winning arrangement as including a wild symbol forming multiple winning arrangements it is not relied upon for such a teaching either. Accordingly the applicant's arguments are non-persuasive as the two described game features are provided for by the combination of prior art as presented herein above.

Second, as address in the preceding paragraph the incorporation of a wild symbol has been addressed in the rejection of record with specific regards to the prior art reference of Bennett and Humano is not relied upon for such teaching in isolation.

Continuing on page 14 of the applicant's remarks the applicant proposes that the prior art reference of Humano teaches away from the applicant's claimed display module because as best understood the claimed invention displays the multiplier on the reel symbol display and provides an advantage therewith not allegedly provided for by

the combination of prior art in conveying the value of the multiplier directly on the multi-line play field.

With reference to the above, the base reference of Bennett teaches the presentation of a multiplier symbol with the presentation of a wild symbol on the reel display (*Bennett* Col 1:61-2:11). Accordingly the applicant's arguments is non-persuasive since the combination of prior art as applied specifically teaches the presentation of the multiplier associated with a wild symbol at the reel location of the multiplier.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT MOSSER whose telephone number is (571)272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Lewis can be reached on (571) 272-7673. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. M./
Examiner, Art Unit 3714

/David L Lewis/
Supervisory Patent Examiner, Art Unit 3714